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Dated: April 22, 2009

Signature: 
(Jay Cleveland)

Docket No.: 61135/P024US/10303362
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Craig Ogg

Application No.: 10/677,829

Confirmation No.: 9780

Filed: October 2, 2003

Art Unit: 3628

For: SYSTEM AND METHOD FOR ACCESSING A
REMOTE POSTAGE METER ACCOUNT
FROM A DEVICE THAT HAS A DEDICATED
LOCAL METER AND ACCOUNT

Examiner: D. Vetter

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Applicant requests review of the rejection in the above-identified application. This request is being filed with a Notice of Appeal and is requested for the reasons stated below.

I. Rejections under 35 U.S.C. § 103

Claims 14-18, 20-21, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,151,591 as to Pierce et al. (hereinafter "Pierce") in view of International Patent Publication No. WO 2002/093498 as to Willoughby, et al. (hereinafter "Willoughby"). Applicant respectfully submits that the proposed combination is improper for multiple reasons. As such, Applicant requests that the rejection be withdrawn.

A. When Examining the Prior Art as a Whole, it is Clear that Pierce and Willoughby Cannot be Properly Combined and that the References Fail to Teach Limitations of the Present Claims

The disclosure of Pierce teaches a completely divergent type of postage metering solution than that of Willoughby, each designed to present a complete solution for two completely different issues. Applicant notes that in examination, ascertaining the differences between the prior art and the claims at issue requires considering both the invention and the prior art

references as a whole. MPEP 2141.02 (emphasis added). When viewing the cited references as a whole, it is clear that they cannot readily be combined. Further, even if one could combine the cited art, the combination would fail to teach the claims of the present application.

Pierce teaches a network system such as one that would be distributed throughout an office, or multiple offices, of a company. Pierce Col. 3 ll. 20-34. This network system is designed to communicate with multiple postage metering devices that are set forth as nodes in the network, in order to either take advantage of the geographic location of other devices and/or to efficiently utilize money resources already owned by the owners of the network. *See* Pierce FIG 1; Col. 5 l. 14 – Col 6 l. 10. Willoughby, on the other hand, discusses a software tool which facilitates a user in utilizing an online shipping API system. *See* Willoughby FIG 1 item 130; [0016]. The shipping system API receives the request for postage, conducts the transaction with a PC vendor, provides all metering services for the system (*i.e.* no local meters are deployed, communicated with, etc.), and records the transaction. *Id.* at [0028], [0030], and [0033]. As can be readily seen, these disparate teachings cannot simply be thrown together because the actual systems are fundamentally different.

In the Final Office Action Examiner takes issue with Applicant's arguments and states that Applicant "presupposes that the shipping system API of Willoughby must be included in the combination." Office Action at 3. Examiner states that this assumption is invalid and asserts that evidence is required to support this assertion. *Id.* By asserting this, Examiner appears to recognize that if the entire API of Willoughby is combined with Pierce, the resulting combination would frustrate the functionality of Pierce. Contrary to Examiner's assertion, however, Willoughby expressly teaches that its entire invention is the API and all functionality flows therefrom. *See e.g.* [0014]. In other words, the API of Willoughby provides all relevant functionality. Surely, the API program of Willoughby cannot be separated from teachings regarding functions of the API itself in order to make a rejection. Examiner cannot separate the functional basis of the system described in Willoughby while asserting to be considering Willoughby as a whole. It is not Applicant who must provide evidence where Applicant is relying on the express teachings of a reference, and Examiner is fundamentally altering the functionality of that reference in the asserted combination. The express teachings of Willoughby contradicts Examiner's position. As such, Examiner must provide justification that supports the feasibility of proposed modification. Without such rational, Applicant lacks sufficient notice of the rejection, and cannot begin to gather the appropriate evidence to rebut Examiner's assertions.

If the teachings of Pierce and Willoughby were attempted to be combined, the functionality of Willoughby would be a misplaced appendage on the network of Pierce, and

would create conflicting functionality. For example, all transaction processing of Pierce is implemented by a central network server in the network. *See* Pierce Col. 6 ll. 6-9. If one with skill in the art were to combine Willoughby with Pierce to provide access to multiple vendors in the network of Pierce, they must also add the functionality of the shipping system API in order to establish communication with the vendor system. However, the shipping system API itself, which is necessary to facilitate interaction with multiple vendor systems, administers transaction processing. As such, the proposed combination would add conflicting transaction processing features. These, and other conflicts, would avert one with skill in the art from making the proposed combination. Further, separate transaction processors would frustrate the “centralized approach concerning transaction accounting ” which is taught in Pierce.

Additionally, the refilling process that Examiner relies on as teaching “reducing a balance on the remote postage account without transferring the value of the postage amount to the local account” could not be carried out with the remote accounts in Willoughby because the algorithms of Willoughby would cause the shipping system API to subvert the functionality of the local PSD of Pierce. Willoughby explicitly describes a postage transaction process, *e.g.* a request is received at the shipping system API to request a postage label and determines the postage rate, the shipping system API retrieves the proper funds from a PC postage vendor, and the shipping system API then generates the label. Willoughby [0032]-[0033]. Whereas Pierce accesses account funds on a separated PSD, while metering is calculated and printed at a local PSD. Pierce Col. 4 ll. 15-21. As such, the vendors of Willoughby would not function as the asserted remote part of the network of Pierce because when a local PSD is attempting to utilize a remote account’s funds, the shipping system API of Willoughby would attempt to meter the postage (which is the task of the local PSD of Pierce). This functionality would also prevent the remote account of Willoughby from transferring money to a device, such as a PSD of Pierce. As shown above, when funds are deducted from a remote vendor account of Willoughby, the shipping system API meters the postage corresponding to such funds. Hence, the funds could not be transferred to the local PSD for subsequent metering by the local PSD.

Further, the proposed combination is also improper because it would frustrate the principle metering operations of Pierce. *See In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (stating if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious); *see also In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or

motivation to make the proposed modification). As shown above, if the proposed combination were implemented, it would not allow funds transfers between a local PSD and the API (which is asserted to function as a PSD), and would disrupt Pierce’s methods for transaction accounting.

Moreover the proposed combination could not function as set forth in the claimed invention. Claim 14 recites “reducing a balance on the remote postage account without transferring the value of the postage amount to the local account.” The Office Action relies on the teachings of Pierce for this limitation. However, it is noted that the remote postage account recited in the claim is “administered by a selected vendor of said plurality of vendors.” In other words, in order to reject claim 14, the balance reduction teachings of Pierce, which utilizes money from a separate PSD, must necessarily work with what the Office Action relies on as remote accounts administered by vendors (of which the Office Action relies on Willoughby as teaching). However, as shown above, the proposed combination prevents such functionality because the shipping system API of Willoughby would attempt to carry out functions of the PSD requesting the funds. Therefore, Examiner cannot rely solely on Pierce for teaching the above recited limitation, and any combination with Willoughby would not create the claimed limitation.

As a result, Applicant respectfully submits that the proposed combination is improper at least because it can not be properly combined by one with skill in the art. Additionally, the proposed combination would not function as required by the claims.

B. The Office Action Fails to Assert a *Prima Facie* Case of Obviousness Because the Asserted Reason to Combine References is Improper

Claim 14 recites “configuring the local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts.” The Office Action admits that Pierce fails to teach this limitation and relies on Willoughby to remedy this deficiency. The Office Action states as its reasoning to combine that “it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the invention to incorporate the above teachings of Willoughby so that a user can select another vendor if a particular remote postage provider suffers downtime.” This rationale for combining the references, however, contains multiple flaws.

For example, as acknowledged by the Examiner, Pierce does not teach any remote vendors. Hence, there is no remote vendor that could be suffering downtime, and therefore there is no reason to add functionality to Pierce to allow for switching between remote vendors. Additionally, there is no reason that the network of Pierce would need to add any additional “down time” compensation. Pierce explicitly discloses that “each client PC has access, if

authorized, to both its own local PSD(s), if any, and any other client PSD(s) in the network.” Col. 3 ll. 31-33. In other words, in Pierce, the network components are in communication with each other. Therefore there would no need to add communication abilities to compensate for down time of a component because such abilities are already present. Hence, one with skill in the art would not have found it obvious to combine Pierce and Willoughby “so that a user can select another vendor if a particular remote postage provider suffers downtime.”

Applicant notes that in making an obviousness rejection, reasoning should be identified that shows “what may have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR v. Teleflex*, 550 U.S. 398; 82 U.S.P.Q.2d 1385 (2007). If these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. *Id.*; MPEP 2143. Because proposed reasons for combining the prior art references fails to show what may have prompted a person of ordinary skill in the relevant field to combine the elements, and no such reasoning can be found, Applicant submits that the above rejection is improper.

Claims 18-23 and 24-27 depend either directly or indirectly from independent claim 14, and thus, inherit each and every limitation of their corresponding independent claim. As a result, claims 18-23 and 24-27 are allowable for at least the reasons set forth above.

II. Conclusion

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejections in the present application. The required fee for the Notice of Appeal filed with this request will be paid by credit card. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 59184/P002C1/10612961 from which the undersigned is authorized to draw. Please charge any fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: April 22, 2009

Respectfully submitted,

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